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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/057,919 | 01/29/2002 | Hisayoshi Tsubaki | FJ-2001-039-US | 3745 |
| 21254 7590 05/31/2007 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817 | | | EXAMINER DULANEY, BENJAMIN O | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/057,919

Applicant(s)

TSUBAKI ET AL.

Examiner

Benjamin O. Dulaney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 3/5/07 have been fully considered but they are not persuasive.

In response to applicant's argument for claim 1 that it would be "completely unreasonable" to equate capturing an image with recording an image, examiner disagrees. While one of ordinary skill in the art would recognize the two words as synonymous (as applicant's own specification does in paragraph 60) in this circumstance, even if they were not, applicant is suggesting that Bernstein is capturing images **WITHOUT** recording them. This is not the invention of Bernstein, and it would be completely illogical to do.

In response to applicant's argument for claim 1, that Bernstein does not teach "service information about said image service provided by said server", Examiner disagrees. "Image service" could simply mean the sending of the service information, which the server in Bernstein certainly does.

In response to applicant's request for documentary evidence for the rejection of claim 9, Examiner has provided U.S. patent 6,384,862 by Brusewitz et al.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1) Claims 1, 2, 4, 5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 6,970,189 by Bernstein et al.
- 2) Regarding claim 1, Bernstein teaches a portable device, comprising: a recording device which records, in a recording medium, an image to be transmitted to a server via a communication device, the server providing image service; and a service information input device which inputs, from the communication device, service information about said image service provided by said server, wherein said recording device records the image based on the inputted service information in the recording medium (Column 5, lines 42-52).
- 3) Regarding claim 2, Bernstein teaches the portable device according to claim 1, wherein the recording device records the service information together with the image in the recording medium (Column 6, lines 46-56).
- 4) Regarding claim 4, Bernstein teaches the portable device according to claim 1, wherein the input device inputs service content information indicating the content of the image service, and wherein the recording device records the service content information together with the image (Column 6, lines 46-56).
- 5) Regarding claim 5, Bernstein teaches the portable device according to claim 1, further comprising: an image-capturing device which captures an image, wherein the

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recording device converts the captured image to an image based on the service information and records the image in the recording medium (Column 5, lines 42-52).

6) Regarding claim 7, Bernstein teaches the portable device according to claim 1, wherein the service information input device reads service information recorded in the recording medium and inputs service information (Column 5, lines 42-52).

7) Regarding claim 8, Bernstein teaches the portable device according to claim 1, wherein the service information input device inputs said service information from said communication device one of wirelessly and via a wire (Column 2, line 61 – Column 3, line 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8) Claims 3, 6 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,970,189 by Bernstein et al., and further in view of U.S. patent 6,967,675 by Ito et al.

9) Regarding claim 3, Bernstein does not teach the portable device according to claim 1, wherein the input device inputs server identifying information for specifying the server together with the service information, and wherein the recording device records the server identifying information together with the image.

Ito teaches the portable device according to claim 1, wherein the input device inputs server identifying information for specifying the server together with the service information, and wherein the recording device records the server identifying information together with the image (Column 7, lines 52-61; Figure 3).

Bernstein and Ito are combinable because they are both from the image communication field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bernstein with Ito to add specifying a server to send images to. The motivation for doing so would have been to have "access to the server" of the user's choice (Column 7, line 61). Therefore it would have been obvious to combine Bernstein with Ito to obtain the invention as specified by claim 3.

10) Regarding claim 6, Bernstein teaches the portable device according to claim 1, further comprising: the recording device converts an image read from the image recording device to an image based on the service information, and records the image in the recording medium (Column 5, lines 42-52).

Bernstein does not teach an image reading device which reads an image from an image recording device for recording an image.

Ito teaches an image reading device which reads an image from an image recording device for recording an image (Column 8, lines 13-21).

Bernstein and Ito are combinable because they are both from the image communication field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bernstein with Ito to add a server reading an image. The motivation for doing so would have been to "execute a transmission process" (Column 8, lines 15-16). Therefore it would have been obvious to combine Bernstein with Ito to obtain the invention as specified by claim 6.

11) Regarding claim 19, Bernstein does not specifically teach the portable device according to claim 1, wherein said image service provided by said server comprises at least one of a printing service for printing said images and a distribution service for distributing said image.

Ito teaches the portable device according to claim 1, wherein said image service provided by said server comprises at least one of a printing service for printing said images and a distribution service for distributing said image (Column 11, lines 33-48).

Bernstein and Ito are combinable because they are both from the image communication field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bernstein with Ito to add a printing service. The motivation for doing so would have been "to provide print service of image files" (Column 11, line 50). Therefore it would have been obvious to combine Bernstein with Ito to obtain the invention as specified by claim 19:

12) Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,970,189 by Bernstein et al. and further in view of U.S. patent 6,384,862 by Brusewitz et al.

Bernstein does not specifically teach the portable device according to claim 1, wherein when specification is made within a permissible range regarding an aspect ratio, the number of pixels, compressibility, or a file size that is included in the service information, the recording device automatically selects one of a maximum value and a minimum value within the permissible range, and records an image based on the selected service information in the recording medium.

Brusewitz teaches the portable device according to claim 1, wherein when specification is made within a permissible range regarding an aspect ratio, the number of pixels, compressibility, or a file size that is included in the service information, the recording device automatically selects one of a maximum value and a minimum value within the permissible range, and records an image based on the selected service information in the recording medium (Column 6, lines 17-41).

Bernstein and Brusewitz are combinable because they are both from the image communication field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bernstein with Brusewitz to add selecting a value in a permissible range. The motivation for doing so would have been because "the viewer may want different image resolution" (Column 5, lines 65-66). Therefore it would have

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been obvious to combine Bernstein with Brusewitz to obtain the invention as specified by claim 9.

12) Claims 10, 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,970,189 by Bernstein et al., and further in view of U.S. patent 6,307,591 by Yoshida et al.

13) Regarding claim 10, Bernstein does not specifically teach the portable device according to claim 1, further comprising: a specifying device which allows a user to specify service information including a predetermined aspect ratio, the number of pixels, compressibility, or a file size within a permissible range when specification is made within the permissible range regarding service information including a predetermined aspect ratio, the number of pixels, compressibility, or a file size, wherein the recording device records an image in the recording medium according to service information specified by the user.

Yoshida teaches the portable device according to claim 1, further comprising: a specifying device which allows a user to specify service information including a predetermined aspect ratio, the number of pixels, compressibility, or a file size within a permissible range when specification is made within the permissible range regarding service information including a predetermined aspect ratio, the number of pixels, compressibility, or a file size, wherein the recording device records an image in the recording medium according to service information specified by the user (Column 7, lines 1-6).

Bernstein and Yoshida are combinable because they are both from the camera-imaging field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bernstein with Yoshida to add user specification of service information. The motivation for doing so would have been so that specifications are "selected by the user" (Column 7, line 3). Therefore it would have been obvious to combine Bernstein with Yoshida to obtain the invention as specified by claim 10.

14) Regarding claim 11, Bernstein does not specifically teach the portable device according to claim 1, further comprising: an input device which allows a user to specify conditions of recording an image, the conditions including an aspect ratio of a predetermined image, the numbers of pixels in vertical and horizontal directions of an image, compressibility for compressing and recording an image, or a file size of an image upon recording, wherein when recording conditions specified by the user are within a permissible range of the corresponding service information inputted from said communication device, an image based on the recording conditions specified by the user is recorded in the recording medium.

Yoshida teaches the portable device according to claim 1, further comprising: an input device which allows a user to specify conditions of recording an image, the conditions including an aspect ratio of a predetermined image, the numbers of pixels in vertical and horizontal directions of an image, compressibility for compressing and recording an image, or a file size of an image upon recording, wherein when recording conditions specified by the user are within a permissible range of the corresponding

service information inputted from said communication device, an image based on the recording conditions specified by the user is recorded in the recording medium (Column 7, lines 1-6).

Bernstein and Yoshida are combinable because they are both from the camera-imaging field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bernstein with Yoshida to add user specification of service information. The motivation for doing so would have been so that specifications are "selected by the user" (Column 7, line 3). Therefore it would have been obvious to combine Bernstein with Yoshida to obtain the invention as specified by claim 11.

15) Regarding claim 21, Bernstein does not specifically teach the portable device according to claim 1, wherein said service information about said image service provided by said server comprises at least one of: format of the image such as an image recording format or an image format; an aspect ratio of the image or a permissible range of the aspect ratio; numbers of pixels in vertical and horizontal directions of the image or a permissible range of the numbers of pixels; and compressibility for compressing and recording the image, a file size of the image upon recording, or a permissible range of the compressibility or the file size.

Yoshida teaches the portable device according to claim 1, wherein said service information about said image service provided by said server comprises at least one of: format of the image such as an image recording format or an image format; an aspect ratio of the image or a permissible range of the aspect ratio; numbers of pixels in

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vertical and horizontal directions of the image or a permissible range of the numbers of pixels; and compressibility for compressing and recording the image, a file size of the image upon recording, or a permissible range of the compressibility or the file size (Column 7, lines 1-6).

Bernstein and Yoshida are combinable because they are both from the camera-imaging field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bernstein with Yoshida to add user specification of service information. The motivation for doing so would have been so that specifications are "selected by the user" (Column 7, line 3). Therefore it would have been obvious to combine Bernstein with Yoshida to obtain the invention as specified by claim 21.

16) Claims 12, 14-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,970,189 by Bernstein et al., and further in view of U.S. patent 6,038,295 by Mattes.

17) Regarding claims 12, 17 and 18, Bernstein teaches a receiving device which receives, from a server, service information about said image service provided by user; a service information output device which outputs the received service information to a portable device, said image being recorded on said recording medium by a portable device based on said service information (Column 5, lines 42-52).

Bernstein does not teach a mobile phone which is capable of performing voice communication, communicating information to a server for providing image service, and

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transmitting an image recorded in a loadable recording medium to the server;
transmitting device which transmits to the server the image read from the recording medium.

Mattes teaches a mobile phone which is capable of performing voice communication, communicating information to a server for providing image service, and transmitting an image recorded in a loadable recording medium to the server; transmitting device which transmits to the server the image read from the recording medium (Column 8, lines 36-45).

Bernstein and Mattes are combinable because they are both from the imaging field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bernstein with Mattes to add a cellular phone. The motivation for doing so would have been "so that photographic images may be obtain by the digital camera portion and transmitted via the telephone portion" (Column 8, lines 39-41). Therefore it would have been obvious to combine Bernstein with Mattes to obtain the invention as specified by claims 12, 17 and 18.

18) Regarding claim 14, Bernstein (as modified by Mattes) teaches the mobile phone according to claim 12, wherein the recording medium records service content information indicating service content of the image, together with the image, and wherein the transmitting device transmits service content information recorded in the recording medium to the server together with the image (Column 6, lines 46-56).

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19) Regarding claim 15, Bernstein (as modified by Mattes) teaches the mobile phone according to claim 12, wherein the service information output device records the received service information in the recording medium and outputs the service information to the portable device via the recording medium (Column 6, lines 46-56).

20) Regarding claim 16, Bernstein (as modified by Mattes) teaches the mobile phone according to claim 12, wherein the service information output device outputs the received service information to the portable device via one of a wireless communication device and a wired communication device (Column 2, line 61 – Column 3, line 9).

21) Regarding claim 20, Bernstein does not teach the portable device according to claim 1, wherein said communication device comprises a mobile phone.

Mattes teaches the portable device according to claim 1, wherein said communication device comprises a mobile phone (Column 8, lines 36-45).

Bernstein and Mattes are combinable because they are both from the imaging field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bernstein with Mattes to add a cellular phone. The motivation for doing so would have been "so that photographic images may be obtain by the digital camera portion and transmitted via the telephone portion" (Column 8, lines 39-41). Therefore it would have been obvious to combine Bernstein with Mattes to obtain the invention as specified by claim 20.

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22) Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,970,189 by Bernstein et al., and further in view of U.S. patent 6,038,295 by Mattes and further in view of U.S. patent 6,967,675 by Ito et al.

Bernstein (as previously modified by Mattes) does not teach the mobile phone according to claim 12, wherein the recording medium records server identifying information for specifying the server, together with the image, and wherein the transmitting device transmits the image to a server specified according to server identifying information recorded in the recording medium.

Ito teaches the mobile phone according to claim 12, wherein the recording medium records server identifying information for specifying the server, together with the image, and wherein the transmitting device transmits the image to a server specified according to server identifying information recorded in the recording medium (Column 7, lines 52-61; Figure 3).

Bernstein (as previously modified by Mattes) and Ito are combinable because they are both from the image communication field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bernstein (as previously modified by Mattes) with Ito to add specifying a server to send images to. The motivation for doing so would have been to have "access to the server" of the user's choice (Column 7, line 61). Therefore it would have been obvious to combine Bernstein (as previously modified by Mattes) with Ito to obtain the invention as specified by claim 13.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

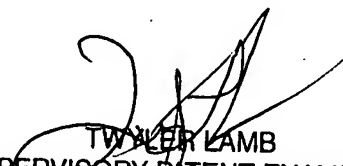
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin O. Dulaney whose telephone number is (571) 272-2874. The examiner can normally be reached on Monday - Friday (9am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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